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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,284	04/12/2004	Chang-Hai Chen		4349

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EXAMINER

MUI, CHRISTINE T

ART UNIT	PAPER NUMBER
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1709

MAIL DATE	DELIVERY MODE
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09/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/822,284	CHEN ET AL.	
	Examiner	Art Unit	
	Christine T. Mui	1709	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

Oath/Declaration

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that

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the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because in the abstract,
3. On line 4, in the instance where it reads "transfer the blood", probably should read "transfer blood" where "the" should be deleted
4. On line 4, in the instance where it reads "plate, and two", probably should read "plate, two" where "and" should be deleted
5. On line 6, in the instance where it reads "where can", probably should read "where it can" where "it" should be added
6. On line 7, in the instance where it reads "blood from fingertip", probably should read "blood from the fingertip" or "blood from a fingertip" where "from" or "a" should be added
7. On line 9, in the instance where it reads "release pressure and then the" probably should read "release pressure, the" where a "," should be added and "and then" should be deleted.
8. Correction is required. See MPEP § 608.01(b).
9. The disclosure is objected to because of the following informalities:
10. In the BACKGROUND OF THE INVENTION

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11. On line 4, in the instance where it reads "in touched" probably should be "in touch"
12. On line 6, in the instance where it reads "Connecting one side of the plate" probably should read "One side of the plate is connected"
13. On line 9, in the instance where it reads "Then, remove" probably should read "Then remove"
14. On line 10, in the instance where it reads "not get in touch" probably should read "not get in contact"
15. On line 12, in the instance where it reads "such electronic" probably should read "such an electronic"
16. On line 13, in the instance where it reads "If" probably should read "If there is"
17. On line 16, in the instance where it reads "plate adopts electrode plate" probably should read "plate adopts the electrode plate".
18. In the SUMMARY OF THE INVENTION
19. On line 5, in the instance where it reads "safety and hygiene" probably should read "safety and hygiene." A "." needs to complete a sentence.
20. On line 8, in the instance where it reads "air holes for finger pressing" probably should read "air holes for the finger to press"
21. On line 9, in the instance where it reads "Pressing the press" probably should read "By pressing the press"
22. On line 10, in the instance where it reads "pressure and then the air" probably should read "pressure the air".

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23. In the DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT

24. On line 3, in the instance where it reads "transfer the blood" probably should read "transfer blood"

25. On line 12, in the instance where it reads "release the pleasure" probably should read "release the pressure".

Appropriate correction is required.

Claim Objections

1. Claim 1 is objected to because of the following informalities:

2. There are multiple periods in the claim. Periods may not be used elsewhere in the claims except for abbreviations.

3. On line 5, in the instance where it reads, "top with may air holes" probably should read "top with many holes".

4. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly

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and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over USP 6,458,258 to Taniike et al (herein referred "Taniike"), and further in view of US Publication No. 2002/0077584 A1 to Lin et al (herein referred "Lin").

11. Taniike discloses the claimed invention except for the air holes located around the external periphery of the finger press area that opens and closes when pressure is applied. Taniike discloses a biosensor having a favorable response characteristic up to high concentration ranges, a low blank response and a high storage stability (see abstract). The biosensor that Taniike discloses comprises of a biosensor with an electrically insulating base plate, an electrically insulating cover member for forming a sample solution supply pathway or a sample solution storage section between the cover member (upper plate) and the base plate (lower plate), a working electrode (electrode) formed on the base plate and a counter electrode (electrode) formed on the inner surface of the cover member (see column 3, lines 43-52). The cover member comprises of a sheet member having an outwardly expanded curved section (convex arc-shaped) (see column 3, lines 57-58; Figure 3). The cover member also has an air vent (sucking hole) that communicates with the sample solution supply pathway (see column 5, lines 39-41). Lin discloses a transdermal agent sampling device where there is a microblade array that applies a partial vacuum (see abstract). As seen in Figure 8, when there is pressure applied to the top of the body by applying finger pressure by a finger, the downward pressure causes the microblades to penetrate the skin. When the

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finger applies the downward pressure, the volume of the chamber is decreased and the air is forced out by the one-way valve by the applied finger pressure. Next, when the finger pressure is removed, the dome-shaped member, due to its elastic property springs back into its original shape and creating a partial vacuum (see [0028]). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct multiple one-way valves in Lin around the external periphery of the convex-shaped member to open when finger pressure is applied and closed when finger pressure is released to deflate the press area in a short amount of time and create a partial vacuum to suction the blood from the finger.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USP 6,599,407 to Taniike et al; 6,562,014 to Lin et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine T. Mui whose telephone number is (571) 270-3243. The examiner can normally be reached on Monday-Friday 8-5; Alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on (571) 272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CTM


WALTER D. GRIFFIN
SUPERVISORY PATENT EXAMINER